

## **REMARKS**

### **I. Introduction**

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claims 1-47, 49-100, 102-103, 105, 108, and 110, are requested to be cancelled. The cancellation of claims does not constitute acquiescence in the propriety of any rejection set forth by the Examiner. Applicants reserves the right to pursue the subject matter of the canceled claims in subsequent divisional applications.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claims remain under examination in the application, is presented, with an appropriate defined status identifier.

Upon entry of this Amendment, claims 48, 101, 104, 106-107, 109, 111-113 will remain pending in the application.

Because the foregoing amendments do not introduce new matter, entry thereof by the Examiner is respectfully requested.

### **II. Response to Issues Raised by Examiner in Outstanding Office Action**

#### **a. Claim Rejections - 35 U.S.C. § 103**

Claims 48, 101, 104, 106-107, 109, 111-113 are rejected under 35 U.S.C. § 103(a) as being obvious over Gemba (US 6,214,855) in view of Koudst (US 5,648,331). Applicant respectfully requests reconsideration and withdrawal of the rejection.

The Office asserts that an obviousness rejection should be considered in light of *Graham*. See Office Action p. 2. Applicant notes MPEP § 2141.01 (I) which provides, “Before answering *Graham's* 'content' inquiry, it must be known whether a patent or publication is in the prior art under 35 U.S.C. § 102.” *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593, 1597 (Fed. Cir.), *cert. denied*, 481 U.S. 1052 (1987).

Subject matter that is prior art under 35 U.S.C. 102 can be used to support a rejection under section 103. *Ex parte Andresen*, 212 USPQ 100, 102 (Bd. Pat. App. & Inter. 1981) ("it appears to us that the commentator [of 35 U.S.C.A.] and the [congressional] committee viewed section 103 as including all of the various bars to a patent as set forth in section 102."). A 35 U.S.C. 103 rejection is based on 35 U.S.C. 102(a), 102(b), 102(e), etc. depending on the type of prior art reference used and its publication or issue date.

Applicant does not believe Gemba may serve as prior art under 102(a), 102(b), or 102(e). For 102(a): the priority date of the present application (October 14, 1998) is prior to the publication date of the PCT application corresponding to Gemba (October 29, 1998). A certified English translation of the priority documents is enclosed or has been filed previously. For 102(b): The filing date of the present application (October 7, 1999) is less than 1 year from the publication date of the PCT application corresponding to Gemba (October 29, 1998). For 102(e): The priority date of the present application is prior to the 102(e) date of Gemba (September 29, 1999). As Gemba does not provide a basis as prior art under § 102, Applicant believes Gemba cannot serve as the basis for a rejection under § 103(a). Applicant respectfully requests reconsideration and withdrawal of the rejection.

**CONCLUSION**

The present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant(s) hereby petition(s) for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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